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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Inventors: Todd Robert COLAS et al. Group Art Unit: 3622
Serial No.: 09/935,120 Examiner: Y. Retta
Filed: August 22, 2001
For: ELECTRONIC ADVERTISEMENT SYSTEM AND METHOD

DECLARATION UNDER 37 C.F.R. 1.132

I, HOWARD UNGAR, am over 21 years of age, and if called to testify would be competent to testify as to the following matters:

- (1) I have been a computer consultant for five years, attended college at the University of Michigan and received a Bachelor of Science in Electrical Engineering in year 1984, attended graduate school at the University of Southern California and received a Masters of Science in Computer Science in 1991.
- (2) My experience relevant to this case includes designing and programming database systems utilizing J2EE Enterprise Java Beans (EJB), XML, and template systems.
- (3) I have never testified before or acted as an expert witness.
- (4) I have been employed for two and a half years as an independent consultant by DynAccSys, the Assignee of U.S. Patent Application No. 09/935,120 entitled "Electronic Advertising System and Method". I am being compensated for my time in preparing this Opinion by the Assignee, however I have no financial interest in the outcome of the prosecution of U.S. Patent Application No. 09/935,120.
- (5) I am familiar with the prosecution history of Application No. 09/935,120: I have received copies of and read:
 1. the patent application filed on August 22, 2001 and published as Pub. No. US 2003/0046152 on March 6, 2003
 2. the first Office action mailed on November 6, 2002 and the references cited therein;
 3. the Applicants' response to the first Office Action filed on May 6, 2003;
 4. the Final Rejection mailed on July 24, 2003 and the references cited therein;
 5. the Applications' response to the Final Rejection filed on October 24, 2003; and
 6. the Examiner's Advisory Action mailed on November 6, 2003.

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I am aware that an office interview was conducted on September 10, 2003, which was summarized in the Applicants response to the Final Rejection filed on October 24, 2003.

(6) I am fully familiar with and deal with the following technologies on a daily basis:

1. The XML standard and its uses.
2. JAVA Beans and Enterprise Java Beans (EJB).
3. Development and use of business rules.
4. Use of templates in controlling user interfaces.
5. Use of roles in controlling access to data and data manipulation functions; and
6. Combining business rules, access roles and templates to develop software applications.

In reviewing these materials I have the following observations:

- (1) I disagree with the Examiner's allegation in the Advisory Action mailed November 6, 2003 that "ordinary skill in the art would know that the rules are stored within the database". The cited ILOG JRules press release clearly states that "another first-ever feature in ILOG Jrules 3.0 is XML rule representation that allows rules to be shared across applications, and allows standard XML tools to be used to generate executable rules". In my experience the characterization of a library of XML files as a database is contrary to the commonly held views of those skilled in the art. My experience with standard XML tools is that they store the resulting XML files in flat files on the operating system. For examples see eXcelon Stylus Studio described at http://www.sonicsoftware.com/products/sonic_stylus_studio/index.ssp , or XML Spy described at <http://www.xmlspy.com/> .
- (2) When one refers to a "database" they are typically discussing a sophisticated piece of software which, in addition to storing data in files (or tables), typically contains a rich set of features including meta-data (data describing the data), storage control mechanisms which control how the data is stored and where, user definition mechanisms, role definition mechanisms, access control mechanisms which restrict access to data and procedures by user and role, code triggers which fire when data is changed, and stored procedures which execute business rules. A database typically contains networking software that allows these features to be accessed remotely.
- (3) On Page 4 of the Final Rejection mailed on July 24, 2003 the Office states that "it would have been obvious to one of ordinary skill in the art at the time of the invention to implement ILOG's software for specifying business rules in Kashino's preparation and administration of ads". In my opinion, the cited ILOG JRules press release does not provide sufficient information about how Business Rules are defined or applied to make it obvious how to create an application. It simply implies that this new version

of their product would make it easier for non-programmers to define Business Rules, but gives no examples of how non-programmers would accomplish this. The cited ILOG JRules press release mentions "XML rule representation". XML is a document description language used to facilitate the exchange of text and business rules. This fact is not directly useful because there is no description in the cited ILOG press release of the format of such rules. The cited ILOG JRules press release mentions "Complete integration with Enterprise Java Beans (EJBs)" but does provide any details of the mechanisms that would be used to access the Business Rules from an EJB environment. Therefore, it would not have been at all obvious to a worker of ordinary skill in this art, given this article, how to implement a set of Business Rules in an application for advertisement construction and publication.

- (5) On page 6 of the patent application filed on August 22, 2001 paragraphs [0107] and [0108] clearly define that the database being described here "is provided for persistent store of all the data and templates ... embodying Company and Publisher Business Rules". It goes on to state that, " Each role established for Company and Publisher personnel is reflected in access privileges to both the data stored in this Company and Publisher database and the functions for manipulating this stored data." Anyone with ordinary skill in the art reading this information would be able to conclude that the invention is assuming the kind of sophisticated database described in this affidavit in section (2) above. Clearly, this database is not only storing the Business Rules, Templates and data, but is controlling user's roles and their access to various aspects of this system.
- (6) In my opinion, none of the references cited by the Examiner describes, suggests or implies
- a. Storing rules and roles in a database
 - b. A template and a template of templates each having parts or component; or
 - c. Associating rules and roles with parts or components of a template.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful statements may jeopardize the validity of the application or any patent issuing thereon.


HOWARD UNGAR

12/18/03
DATE